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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/630,015	07/31/2000	Aysha Saeed	5156-01	6450

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EXAMINER

BLECK, CAROLYN M

ART UNIT PAPER NUMBER

3626

DATE MAILED: 05/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/630,015

Applicant(s)

SAEED ET AL.

Examiner

Carolyn M Bleck

Art Unit

3626

MLW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6 is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9 March 2004 has been entered.
2. This communication is in response to the RCE filed 9 March 2004. Claims 1-7 and 10 are pending. Claims 1-7 and 10 have been amended. Claims 8-9 and 11-15 have been cancelled.

Claim Objections

3. Claim 7, line 27, is objected to because of the following informalities: "wherein said standardized said administrative data format" appears grammatically incorrect. Claim 7, line 27, is being interpreted as "wherein said standardized administrative data format". Appropriate correction is requested.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 3626

5. Claims 2, 4, 5, 7, and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(A) As per claim 2, line 2, claim 4, line 3, and claim 5, line 4, "said medical service provider system" lacks proper antecedent basis. For purposes of applying prior art, "said medical service provider system" is being interpreted as "said service provider system."

(B) As per claim 7, lines 13-14, line 17, lines 21-22, and lines 25, "the medical practice agent systems" lacks proper antecedent basis. For purposes of applying prior art, "the medical practice agent systems" is being interpreted as "the medical practice management agent systems."

(C) Claim 10 incorporates the deficiencies of claim 7, and is therefore rejected for the same reasons as claim 7.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Art Unit: 3626

7. Claims 1, 4, and 5 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

(A) For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the “progress of science and the useful arts” (i.e., the physical sciences as opposed to social sciences, for example), and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the process must somehow apply, involve, use, or advance the technological arts.

In the present case, claim 1 only recites an abstract idea. The recited steps of defining standard administrative data formats..., receiving administrative data..., formatting said administrative data..., providing formatted administrative data..., tracking the formatted administrative data..., creating objective, historical evaluation data..., and providing said objective, historical evaluation data... does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to provide objective historical evaluation data to a service provider system.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention provides objective historical evaluation data to a service provider system (i.e., repeatable) used for processing administrative data in a medical environment (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention as a whole, is not within the technological arts as explained above, claim 1 is deemed to be directed to non-statutory subject matter.

(B) Claims 4 and 5 likewise do not recite the use of technological arts in providing a practical application, and are rejected under the same analysis provided for claim 1, and incorporated herein.

(C) As per claim 6, the Examiner respectfully submits the following interpretation of the means-plus-function language found in the claim: it is assumed the “means for...” described in claim 6 is a computer (pg. 14-18 of Applicant’s specification). Thus, claim 6 appears to recite a practical application in the technological arts, and is therefore statutory.

(D) As per claim 7, the Examiner respectfully submits the following interpretation of the “coordinator system” found in the claim: it is assumed the “coordinator system” is a computer containing the modules described in claim 6 (pg. 14-18 of Applicant’s

-Art Unit: 3626

specification). Thus, claim 7 appears to recite a practical application in the technological arts, and is therefore statutory.

Allowable Subject Matter

8. Claims 1-5, 7, and 10 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 101 and 35 U.S.C. 112, second paragraph, set forth in this Office action.

(A) Claims 1-5, if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 101 and 35 U.S.C. 112, second paragraph, would be allowable for the steps of:

- defining standard administrative data formats for use by service provider systems, a coordinator system, and a plurality of practice management agent systems, said practice management agent systems being independent of payer systems, in creating and processing administrative data;
- tracking formatted administrative data transferred between the service provider system and practice management agent systems;
- creating objective, historical evaluation data from the tracked formatted administrative data transferred between said service provider system and said practice management agent systems, said objective historical

evaluation data consisting of price, features, turnaround time, ancillary services, guarantees, and customer service information; and

- providing said objective historical evaluation data to said service provider system for evaluation and selection of a practice management agent system from the plurality of practice management agent systems,

within the specific combination of steps recited in independent claim 1.

The closest prior art (Spurgeon US Patent No. 5,890,129) teaches a method for exchanging health care insurance, clinical, and business information between insurer and multiple health care providers for efficient administration of services in the health care delivery system, but does not disclose or fairly suggest the use of defining standard administrative data formats for use by service provider systems, a coordinator system, and a plurality of practice management agent systems, said practice management agent systems being independent of payer systems, in creating and processing administrative data, tracking formatted administrative data transferred between a service provider system and practice management agent systems, creating objective, historical evaluation data from the tracked formatted administrative data transferred between said service provider system and said practice management agent systems, said objective historical evaluation data consisting of price, features, turnaround time, ancillary services, guarantees, and customer service information, and providing said objective historical evaluation data to said service provider system for evaluation and selection of a practice management agent system from the plurality of practice management agent systems.

Art Unit: 3626

Claims 2-5 incorporate the features of claim 1 through dependency, and would also be allowed for the same reasons given above.

(B) Claims 7 and 10, if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 101 and 35 U.S.C. 112, second paragraph, would be allowable for the elements of:

a system for providing administrative services for a medical service provider comprising coordinator system for standardizing administrative data formats for processing administrative data of a medical service provider system by a first medical practice management agent system, said medical practice management agent systems being independent of payer systems, said coordinator system providing data access authorization and security for said administrative data of said medical service provider system to said first medical practice management agent system, and for providing evaluation data from said first medical practice management agent system for evaluation by said medical service provider system within the specific combination of elements recited in claim 7. Further, claim 7 includes an interface module located within the coordinator system for accessing the administrative data generated in the standardized data format, said interface module transfers the administrative data to the medical practice management agent systems and transfers processed data from the medical practice management agent systems to the medical service provider system, an evaluation module located within the coordinator system for creating historical performance data based upon administrative data processing by said medical practice

Art Unit: 3626

management agent systems, a first communication link between said service provider system and said coordinator system, a second communication link between said medical practice management agent system and said coordinator system, wherein said standardized administrative data format substantially eliminates costs incurred by said medical service provider system for switching from said first medical practice management agent system to a second medical practice management agent system.

The closest prior art (Spurgeon US Patent No. 5,890,129) teaches a system for exchanging health care insurance, clinical, and business information between insurer and multiple health care providers for efficient administration of services in the health care delivery system, but does not disclose or fairly suggest the use of a system for providing administrative services for a medical service provider comprising coordinator system for standardizing administrative data formats for processing administrative data of a medical service provider system by a first medical practice management agent system, said medical practice management agent systems being independent of payer systems, said coordinator system providing data access authorization and security for said administrative data of said medical service provider system to said first medical practice management agent system, and for providing evaluation data from said first medical practice management agent system for evaluation by said medical service provider system. More specifically, Spurgeon does not disclose an interface module located within the coordinator system for accessing the administrative data generated in the standardized data format, said interface module transfers the administrative data to the medical practice management agent systems and transfers processed data from the

Art Unit: 3626

medical practice management agent systems to the medical service provider system, an evaluation module located within the coordinator system for creating historical performance data based upon administrative data processing by said medical practice management agent systems, a first communication link between said service provider system and said coordinator system, a second communication link between said medical practice management agent system and said coordinator system, wherein said standardized administrative data format substantially eliminates costs incurred by said medical service provider system for switching from said first medical practice management agent system to a second medical practice management agent system.

Claim 10 incorporates the features of claim 7 through dependency, and would also be allowed for the same reasons given above.

9. Claim 6 is allowed.

10. The following is an examiner's statement of reasons for allowance:

Claim 6 is directed towards an agent-neutral computerized system for providing administrative services for a medical service provider comprising a means for defining standard administrative data formats for use by service provider systems, a coordinator system, and a plurality of practice management agent systems, said practice management agent systems being independent of payer systems in creating and processing administrative data. Further, claim 6 is directed towards a means for tracking formatted administrative data transferred between a service provider system

Art Unit: 3626

and practice management agent systems, a means for creating objective, historical evaluation data from the tracked formatted administrative data transferred between said service provider system and said practice management agent systems, said objective historical evaluation data consisting of price, features, turnaround time, ancillary services, guarantees, and customer service information, and a means for providing said objective historical evaluation data to said service provider system for evaluation and selection of a practice management agent system from the plurality of practice management agent systems.

The closest prior art (Spurgeon US Patent No. 5,890,129) teaches a method for exchanging health care insurance, clinical, and business information between insurer and multiple health care providers for efficient administration of services in the health care delivery system, but does not disclose or fairly suggest the use of a means for defining standard administrative data formats for use by service provider systems, a coordinator system, and a plurality of practice management agent systems, said practice management agent systems being independent of payer systems in creating and processing administrative data. More specifically, Spurgeon does not disclose a means for tracking formatted administrative data transferred between a service provider system and practice management agent systems, a means for creating objective, historical evaluation data from the tracked formatted administrative data transferred between said service provider system and said practice management agent systems, said objective historical evaluation data consisting of price, features, turnaround time, ancillary services, guarantees, and customer service information, and a means for

Art Unit: 3626

providing said objective historical evaluation data to said service provider system for evaluation and selection of a practice management agent system from the plurality of practice management agent systems.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied prior art teaches a system and method for detecting fraudulent medical claims via examination of service codes (5,253,164), method and apparatus for making payments and delivering payment information (6,311,170), a payment management system (US 2002/0111886 A1), a method and system for automatic communication between tenderers and requesters (WO 03/094062 A2), Why Non-Health care payers are automating claims? (Automated Medical Payments News, v3, n3, May 6, 1994, Dialog # 02368138/ 636), and the Digital Divide over using the internet for billing (Frook, John Evan, InternetWeek, June 15, 1998, n719 p. 9, Dialog # 00498423/9).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (703) 305-

Art Unit: 3626

3981. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (703) 305-9588.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 306-1113.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

13. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

(703) 872-9306 or (703) 872-9326

[Official communications]

Art Unit: 3626

(703) 872-9327 [After Final communications labeled "Box AF"]

(703) 746-8374 [Informal/ Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,
Arlington, VA, 7th Floor (Receptionist).

CB

CB
May 17, 2004



JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600